

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.16

Express Mail Label Number

Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Phillip Lehr

APPLICATION NO: 10/509,259

FILED: May 3, 2005

FOR: PIPERAZINYL- OR PIPERIDINYLAMINE-SULFAMIC ACID AMIDES
AS INHIBITORS OF STEROID SULFATASE

MS: Amendment

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This Reply is submitted in response to the Office Action mailed September 21, 2007, wherein the pending claims are held subject to restriction. Reconsideration is respectfully requested.

REMARKS/ARGUMENTS

It is stated in the Office Action that the application claims groups of inventions that are not so limited to form a general concept under PCT Rule 13.1. The Office Action groups the subject matter of the application into Group I and Group II allegedly because the inventions listed in Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical features as defined as a lack of a common structural element shared by all of the alternatives (e.g., paragraph (f)(i)(B)(1) cited by the Office Action).

As the Office Action is understood, the ground for the lack of unity of invention is based the holding that the compound core of Formula I in claim 1 was present in the existing prior art. See, page 4 of the Office Action. Applicants respectfully disagree. The Office Action fails to

establish that any compound possessing the core structure of the compounds of Formula I, e.g., a $\text{NS(O)}_2\text{N(H)C(O)}$ core, was known in the prior art prior to the filing or priority date of the instant application.

As the Office Action is understood, the Examiner has conducted a sample STN search of the Registry database which identified two compounds which may satisfy the search terms. The structure of the sample answers were not disclosed in the Office Action. Applicants respectfully point out that the international application from which the instant application claims priority under §371 published in 2003 as WO03/082842. The compounds disclosed the instant application will therefore be incorporated into the Registry database and should turn up in the Examiner's search. Consequently, the Office Action fails to produce any evidence establishing a lack of unity of invention for the instant application.

Applicant respectfully requests request that the restriction requirement be withdrawn and that claims 1-10 be examined on the merits.

Solely for the purposes of providing a complete reply, Applicants elect with traverse compounds, compositions and methods of Formula I where the group NR^1R^2 is NH-piperidine. Applicants further elect the compound of Example 1 for purposes of initial examination.

Respectfully submitted,

Novartis
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, NJ 07936-1080
(617) 871-3105



John Alexander
Attorney for Applicants
Reg. No. 48,399

Date:

17 October 2007